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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,051	06/01/2001	Carl Frederick Behr	38-21(52258)B	3101

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EXAMINER

KRUSE, DAVID H

ART UNIT

PAPER NUMBER

1638

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,051

Applicant(s)

BEHR ET AL.

Examiner

David H Kruse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
 - I. Claims 1-5, and 15, drawn to a DNA construct, a plant comprising said construct and a method of making said plant, classified in class 800, subclass 300.1, for example.
 - II. Claim 6, drawn to a DNA construct comprising *Zea mays* genomic DNA, construct vector DNA and rice actin 1 promoter DNA (SEQ ID NO: 7), classified in class 435, subclass 320.1, for example.
 - III. Claim 6, drawn to a DNA construct comprising *A. tumefaciens* nos 3' terminator DNA, construct vector DNA, *Zea mays* plastid genes rps11 and rpoA, and *Zea mays* genomic DNA (SEQ ID NO: 8), classified in class 435, subclass 320.1, for example.
 - IV. Claims 7, 9, 11, 13 and 16, drawn to PCR primer DNA molecules and a method of detecting the presence of a DNA molecule in a corn plant using said method, directed to SEQ ID NOs: 7, 9 and 10, classified in class 435, subclass 6, for example.
 - V. Claims 7, 8, 11, 13 and 16, drawn to PCR primer DNA molecules and a method of detecting the presence of a DNA molecule in a corn plant using said method, directed to SEQ ID NOs: 8, 11 and 12, classified in class 435, subclass 6, for example.

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- VI. Claim 10, drawn to a corn plant that produces an amplicon using SEQ ID NOs: 9 and 10, classified in class 800, subclass 300.1, for example.
- VII. Claim 10, drawn to a corn plant that produces an amplicon using SEQ ID NOs: 11 and 12, classified in class 800, subclass 300.1.
- VIII. Claim 12, drawn to a method of detecting the presence of a DNA molecule comprising SEQ ID NO: 7, comprising SEQ ID NOs: 9 and 10, classified in class 435, subclass 6, for example.
- IX. Claim 12, drawn to a method of detecting the presence of a DNA molecule comprising SEQ ID NO: 8, comprising SEQ ID NOs: 11 and 12, classified in class 435, subclass 6, for example.
- X. Claim 14, drawn to a method of breeding corn plant using a molecular marker directed to SEQ ID NO: 7, comprising markers designated as SEQ ID NOs: 9 and 10, classified in class 800, subclass 267, for example.
- XI. Claim 14, drawn to a method of breeding corn plant using a molecular marker directed to SEQ ID NO: 8, comprising markers designated as SEQ ID NOs: 11 and 12, classified in class 800, subclass 267, for example.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA construct of Group

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II can be used in a materially different process than that of Group I, such as the method of Group VIII.

3. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA construct of Group III can be used in a materially different process than that of Group I, such as the method of Group IX.

4. Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the PCR primer DNA molecules of Group IV cannot be used to produce the plant of Group I.

5. Inventions I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the PCR primer DNA molecules of Group V cannot be used to produce the plant of Group I.

6. Inventions I and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In

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the instant case the different inventions are unrelated because the product of the method of Group I is structurally and compositionally distinct from the corn plant of Group VI. The corn plant of Group VI can comprise only one of the expression cassettes of Group I, and thus is distinct.

7. Inventions I and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the product of the method of Group I is structurally and compositionally distinct from the corn plant of Group VII. The corn plant of Group VII can comprise only one of the expression cassettes of Group I, and thus is distinct.

8. Inventions I and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method of Group VIII cannot be used to produce the corn plant of Group I, and has different method steps, starting materials and end products than that of Group I.

9. Inventions I and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method of Group IX

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cannot be used to produce the corn plant of Group I, and has different method steps, starting materials and end products than that of Group I.

10. Inventions I and X and XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the methods of Groups X and XI have different method steps, different starting materials and different end products than the method of Group I.

11. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the DNA construct of Group II is compositionally, functionally and structurally distinct from the DNA construct of Group III.

12. Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the PCR primer DNA molecules of Group IV are structurally, functionally and compositionally distinct from the DNA construct of Group II.

13. Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

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operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the PCR primer DNA molecules of Group V are structurally, functionally and compositionally distinct from the DNA construct of Group II.

14. Inventions II and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the corn plant of Group VI is structurally, compositionally and functionally distinct from the DNA construct of Group II.

15. Inventions II and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the corn plant of Group VII is structurally, compositionally and functionally distinct from the DNA construct of Group II.

16. Inventions II and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA

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construct of Group II can be used in a materially different process, such as the method of breeding corn of Group X.

17. Inventions II and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the DNA construct of Group II cannot be used in the method of Group IX.

18. Inventions II and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA construct of Group II can be used in a materially different method than that of Group X, such as the method of Group VII.

19. Inventions II and XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the DNA construct of Group II cannot be used in the method of Group XI.

20. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In

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the instant case the different inventions are unrelated because the DNA construct of Group III cannot be used in the method of Group IV.

21. Inventions III and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA construct of Group III can be used in a materially different method than that of Group IV, such as the method of Group XI.

22. Inventions III and VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the DNA construct of Group III is structurally, compositionally and functionally distinct from the corn plant of either Group VI or Group VII.

23. Inventions III and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the DNA construct of Group III cannot be used in the method of Group VIII.

24. Inventions III and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

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process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA construct of Group III can be used in a materially different method such as that of Group XI.

25. Inventions III and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the DNA construct of Group III cannot be used in the method of Group X.

26. Inventions III and XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA construct of Group III can be used in a materially different method than that of Group XI, such as the method of Group IX.

27. Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method of Group IV has different method steps and different starting products than the method of Group V.

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28. Inventions IV and VI and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method of Group IV cannot be used to make the corn plant of either Group VI or Group VII.

29. Inventions IV and VIII-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method of Group IV has different starting materials and different method steps than any of Groups VIII-XI.

30. Inventions V and VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method of Group V cannot be used to make the corn plant of either Group VI or Group VII.

31. Inventions V and VIII-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method of Group V has different starting materials and different method steps than any of Groups VIII-XI.

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32. Inventions VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the corn plant of Group VI is structurally and compositionally distinct from the corn plant of Group VII.

33. Inventions VI and VII and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because neither the method of Group VII or Group IX can be used to make the corn plant of Group VI.

34. Inventions VI and X are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the corn plant of Group VI can be made using a materially different process, such as the process encompassed by Group I.

35. Inventions VI and XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method of Group XI cannot be used to produce the corn plant of Groups VI.

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36. Inventions VII and VIII-X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the methods encompassed by Groups VIII-X cannot be used to produce the corn plant of Group VII.

37. Inventions VII and XI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the corn plant of Group VII can be made using a materially different process, such as the process of Group I.

38. Inventions VIII-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because Groups VIII-XI comprise methods, each having different starting materials in addition to different method steps and different end products.

39. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and because the search required for one of the groups is not required for another, restriction for examination purposes as indicated is proper.

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40. Applicant is advised that the reply to this requirement to be complete within one month (not less than 30 days) must include an election of the invention to be examined even though the requirement be traversed (37 CFR § 1.143).

41. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

42. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (703) 306-4539. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Amy Nelson can be reached at (703) 306-3218. The fax telephone number for this Group is (703) 872-9306 Before Final or (703) 872-9307 After Final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Kim Davis whose telephone number is (703) 305-3015.



AMY J. NELSON, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

David H. Kruse, Ph.D.
13 September 2002